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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,273	07/11/2001	Michael J. Geile	100.070US27	1262

34206 7590 09/27/2004  
FOGG AND ASSOCIATES, LLC  
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MINNEAPOLIS, MN 55458-1339

EXAMINER

CUMMING, WILLIAM D

ART UNIT PAPER NUMBER

2683

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/903,273

Applicant(s)

GEILE, ANDERSON, BREDE &  
KIRSCHT

Examiner

WILLIAM D CUMMING

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 19-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2, 3, 4, 5, 19, 20, 21, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bingham, et al** in view of **Clark, et al**.

**Bingham, et al** disclose all subject matter, note paragraph 3 of the Office action dated January 9, 2004, except for the subbands having a number of payload channels and a control channel in each subband. **Clark, et al** is evidence that subbands having a number of payload channels and a control channel in each subband is about 32 year old subject matter and well known in the art. The Examiner takes Official Notice as such and the evidence shows that the Applicants did not invent subbands having a number of payload channels and a control channel in each subband. Hence, it would have very obvious for one ordinary skill in the art at the time the claimed invention was made to incorporate the three decades old and well known use of subbands having a number of payload channels and a control channel in each subband in the telecommunication system of **Bingham, et al** in order the telecommunication system to maximize bandwidth and control data and traffic within the telecommunication system.

Regarding claim 20, please note column 3, lines 50-65 and other places in **Bingham, et al**.

Regarding claims 4, 5, 26, and 27, note paragraph 6, of the Office action of dated January 9, 2004.

***Response to Amendment*****5. Patent Application Publications May Now Include Amendments**

As a consequence of the use of Image File Wrappers (IFW), the United States Patent and Trademark Office (Office) has begun to publish patent applications with amendments that expedite the publication process. For example, the patent application publication may be based upon amendments to the specification that are reflected in a substitute specification, an amendment to the abstract, amendments to the claims that are reflected in a complete claim listing, and amendments to the drawings that are reflected in replacement drawing sheets, provided that such substitute specification or amendment is submitted in sufficient time to be entered into the application file wrapper before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin between fourteen and nine weeks prior to the projected date of publication (the projected publication date is indicated on the filing receipt for the patent application). Accordingly, the provisions 37 CFR 1.215(a) are waived to the extent that they are inconsistent with this change in practice. 37 CFR 1.215(a) will be revised consistent with this change in practice, when the rule changes proposed in Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, 68 Fed. Reg. 53816 (Sept. 12, 2003), 1275 Off. Gaz. Pat. Office Notices 23 (Oct 7, 2003) are made final.

Although the Office has begun to include amendments in patent application publications, applicants desiring to ensure that a patent application publication reflects an amendment should submit the application, as amended, through the Electronic Filing System (EFS). See 37 CFR 1.215(c). See also Helpful Hints Regarding Publication of Patent Applications, 1249 Off. Gaz. Pat. Office Notices 83 (August 21, 2001). In addition, if the application is not maintained in an IFW, and the amended application is not submitted through EFS, a petition under 37 CFR 1.182 will continue to be necessary for certain drawings to be included in the patent application publication. See Manual of Patent Examining Procedure, Section 507 (8th ed. 2001, rev. 1, Feb. 2003).

General questions regarding publication of patent applications should be directed to the Customer Service Center, Office of Patent Publication, by telephone at (703) 305-8283. Questions regarding the Electronic Filing System should be directed to (703) 305-3028. Questions of a legal nature should be directed to the Office of Patent Legal Administration at (703) 308-6906.

**6. Elimination of Post Office Box in Arlington, Virginia for Patent Related Correspondence**

Effective June 1, 2004, the Office will cease accepting patent-related correspondence addressed to the P.O. Box 2327 Arlington, VA 22202. Effective May 1, 2003, pursuant to 37 CFR 1.1, patent-related correspondence should

have been addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Accordingly, as of May 1, 2003, the provisions of 37 CFR 1.8 (Certificate of Mailing) and 1.10 (Express Mail certificate) that were waived by the Office were no longer waived for correspondence addressed to P.O. Box 2327, Arlington, VA 22202.

In November of 2001, the Office established a Post Office Box in Arlington, Virginia (P.O. Box 2327, Arlington, VA 22202) for use on an emergency basis, and indicated that the Office would continue to accept patent-related correspondence at this Arlington, Virginia Post Office Box and treat such correspondence as if it were addressed as set forth in 37 CFR 1.1 for purposes of 37 CFR 1.8 and 1.10 until further notice. On March 25, 2003, the Office provided notice that persons submitting correspondence to the Office should no longer use the Arlington, Virginia Post Office Box for any correspondence (including sequence listings in electronic format) after May 1, 2003. See Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

Correspondence in patent-related matters to organizations reporting to the Commissioner for Patents must be addressed to:

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Appropriate mail stops should also be used. See the notice titled "*Special Mail Stops For Patent Mail*" that is published each week in the Official Gazette Notices and posted on the USPTO Internet web site.

Questions regarding this notice may be e-mailed to [PatentPractice@uspto.gov](mailto:PatentPractice@uspto.gov), or directed to the Inventors' Assistance Center (formerly the Patent Assistance Center (PAC)) by telephone at 800-786-9199 or 703-308-4357.

#### 7. Establishment of Mail Stop Post Issue; Revision and Deletion of Certain Mail Stops

Effective April 27, 2004, the United States Patent and Trademark Office (USPTO) has established a new mail stop, Mail Stop Post Issue, and several mail stops have been deleted, or changed. Correspondence that should be directed to Mail Stop Post Issue includes correspondence in applications that have issued as a patent, such as requests for changes of address (other than a fee address, which should be addressed to Mail Stop M Correspondence), powers of attorney, revocations of powers of attorney, withdrawal of attorney, and submissions under 37 CFR 1.501.

The mail stops that should no longer be used are: Mail Stop Application Number; Mail Stop CPA; Mail Stop Design; Mail Stop Non-Fee Amendment; Mail Stop Patent Application; and Mail Stop Provisional Patent Application. Correspondence that would have been addressed to these mail stops no longer needs a specific mail stop. Mail Stop Non-Fee Amendment has been changed to

Mail Stop Amendment. Mail Stop PGPUB-ABD has been changed to Mail Stop Express Abandonment and all requests and petitions for an express abandonment under 37 CFR 1.138 should be directed to this mail stop.

Questions regarding this notice may be e-mailed to [PatentPractice@uspto.gov](mailto:PatentPractice@uspto.gov), or directed to the Inventors' Assistance Center (formerly the Patent Assistance Center (PAC)) by telephone at (800)786-9199, or (703)308-4357.

## 8. Oversized Postcards Must Be Submitted With Sufficient Postage

Recently, a number of return receipt postcards have been returned to the U.S. Patent and Trademark Office (Office) because the postcards contained insufficient postage for an oversized postcard. Oversized postcards require First-Class letter postage. Customers are reminded that they are solely responsible for placing the proper postage on self-addressed postcards that are submitted to the Office for the purpose of obtaining a receipt for correspondence being filed in the Office. Customers should be aware of the following guidance from the USPS regarding postage and acceptability for postcards:

{A} In order to be eligible for the First-Class Mail card rates (currently \$0.23 per card, domestic delivery), cards must be of uniform thickness and made of unfolded and uncreased paper or card stock of approximately the quality and weight of a Postal Service stamped card. Cards claimed at the First-Class postcard rate must be:

- (a) Rectangular;
- (b) No less than 3-1/2 inches high, 5 inches long, and 0.007 inch thick; and
- (c) No more than 4-1/4 inches high, 6 inches long, and 0.016 inch thick.

{B} Cards that measure more than 4-1/4 inches high, 6 inches long, or 0.016 inch thick are charged postage at the First-Class Mail letter rates.

Cards that measure less than 3-1/2 inches high, 5 inches long, and 0.007 inch thick are nonmailable.

Any return receipt postcard that does not contain sufficient postage or is not acceptable may not be delivered by the United States Postal Service (USPS) to the address provided on the postcard, and, if returned to the Office, may be discarded.

For information regarding the Office's postcard receipt practice in patent-related matters, see *Manual of Patent Examining Procedure* (MPEP) (8<sup>th</sup> Ed., Rev. 1, Feb. 2003), Section 503. Questions regarding sufficient postage for postcards should be directed to the United States Postal Service. Questions regarding this notice may be e-mailed to [PatentPractice@uspto.gov](mailto:PatentPractice@uspto.gov), or directed to the Inventors' Assistance Center by telephone at (800)786-9199, or (703)308-4357. 07/01/04

***Response to Arguments***

9. Applicant's arguments with respect to claims 2-5 and 19-35 have been considered but are moot in view of the new ground of rejection.

Applicants' attorney failed traverse the Official notice state in the Office action dated May 21, 2003 and stated very clearly in paragraph 13. To adequately traverse such a finding, an applicants' attorney must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 (*"[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."*). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicants adequately traverse the examiner's assertion of official notice, the examiner must provide documentary evidence if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (*"[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings"* to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicants do not traverse the examiner's assertion of official notice or applicant's



traverse is not adequate, the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. Applicants' attorney traversal is inadequate because:

{a} It was not timely. Applicants' attorney willfully did not traverse the Official notice in the next response and did not seasonably challenge. In re Selmi, 70 USPQ 197; In re Fischer 52 USPQ 473; In re Boon, 169 USPQ 231.

{b} Applicants' attorney failed why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241.

{c} The examiner did provide documentary evidence.

{d} Applicants' attorney failed to provide any evidence that applicants and applicants only invented the well known subject matter.

Regarding, at the headend has least one modem circuit for each transmission channel. The Examiner has withdrawn this obvious statement since **Bingham, et al** inherently must have at least one modem circuit for each transmission channel, at a given time, since if **Bingham, et al** did not, **Bingham, et al** headend would not be able to transmit. **Bingham, et al** would be inoperable. **Bingham, et al** clearly disclose that the headend can transmit and receive, hence must have at least one modem circuit for each and every transmission channel.

### ***Conclusion***

#### **10. All Electronic Copies of Patent Application Records Will Now Be Provided as Certified Copies in Electronic Form**

The United States Patent and Trademark Office (USPTO) is changing to an electronic format for the electronic certified copies it supplies of 1) U.S. patent applications as filed, and 2) U.S. patent-related file wrappers and contents. Copies of U.S. patent application documents made from the USPTO's Image File Wrapper (IFW) electronic system will be provided entirely in electronic form and will always be provided as certified copies. In addition, certified copies of patent application documents will no longer be bound, regardless of whether produced from IFW or a paper file.

For the last two years certified copies of large patent application files produced from the USPTO's electronic systems have been provided only on compact disc, with an attached paper certification statement. Currently, certified copies of patent applications as filed of 400 or more pages and all certified File Wrapper copies produced from IFW are provided on compact disc (CD), both with attached paper certification statements. The \$200 fee for a file wrapper and contents was effectively waived and replaced by a \$55 fee when the application contents are provided on CD. See Copies of File Contents Available on Compact Disc Partial Waiver of 37 CFR 1.19(b), 1278 Off. Gaz. Patent Office 261 (Jan. 27, 2004). The fee for an application as filed remains \$20, as set forth in 37 CFR 1.19(b)(1), even when the copy is provided on compact disc.

**Effective July 30, 2004, all copies of patent documents purchased under 37 CFR 1.19 and produced from IFW will be provided only as electronic files, with an imaged certification statement included as part of a digitally signed PDF (portable document format) file containing TIFF (tag image file format) images of the document pages. These electronic files may be downloaded from the USPTO website or provided by the USPTO on compact disc. The electronic files are digitally signed by the USPTO for authenticity and integrity, and cannot be undetectably modified. As mentioned above, all copies purchased pursuant to 37 CFR 1.19 and produced from IFW will be produced only as certified copies. Uncertified copies may be downloaded under the USPTO's Public PAIR system. Before submitting electronic certified copies of the application as filed supplied on CD or in another electronic form to intellectual property offices under Article 4 of the Paris Convention for the Protection of Industrial Property applicants should inquire whether that office accepts priority documents in electronic form. Although the USPTO provides a certified copy in electronic form, applicants may print the certified copies to paper if required by the intellectual property office to which it is submitted.**

The USPTO is actively engaging in discussions with other intellectual property offices for the mutual acceptance of electronic priority documents. Should another intellectual property office not accept a paper or electronic certified copy of a patent application as filed as described in the above paragraph, upon presentation of a notice

of non-acceptance by the other office, the USPTO will provide a substitute paper copy with a letter signed by an official of the USPTO addressed to the foreign office indicating that the certified copy of the application as filed is to be accepted under **Article 4 of the Paris Convention for the Protection of Industrial Property**. Since the USPTO will no longer bind or rivet paper certified copies of patent applications as filed or file wrappers and contents, copies produced by the Office will be identical to copies printed by an applicant from the electronic certified copy.

Questions regarding this change in practice should be directed to the Office of Public Records at (703) 308-9743.

11. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D CUMMING** whose telephone number is **703-305-4394**. The examiner can normally be reached on Monday-Tuesday 10:30am to 8:30pm.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **WILLIAM TROST** can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

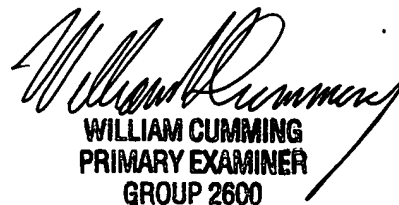
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